

**Pre-Appeal Brief Request for Review**

PATENT APPLICATION  
Docket No. 15814.11.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	)	
	)	
Sani El-Fishawy et al.	)	
	)	
Serial No.:	)	Art Unit
	)	2642
Filed:	)	
	)	
Confirmation No.:	)	
	)	
For:	)	
DELIVERY OF VOICE DATA FROM MULTIMEDIA	)	
MESSAGING SERVICE MESSAGES	)	
	)	
Customer No.:	)	
	)	
Examiner:	)	
Bing Q. Bui	)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop **APPEAL**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A succinct, concise and focused set of arguments for which the panel review is being requested begins on page 2.

## **ARGUMENTS**

Reconsideration of the application by a panel of examiners is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the clear errors and omissions needed for a *prima facie* rejection.

### **Rejections Under 35 U.S.C. § 103**

The Patent Office rejects claims 1-5, 12-13, and 26-35 under 35 U.S.C. § 103(a) as being unpatentable over *Kung* (EP 1 113631 A2) in view of *Bergsman* (U.S. Patent No. 5,146,487). Claims 6-11 and 14-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kung* in view of *Bergsman* and further in view of *Helferich* (U.S. Patent No. 6,636,733).

When applying 35 U.S.C. § 103, “the claimed invention must be considered as a whole” and “the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention”. See MPEP § 2141(II). The following discussion illustrates the invention has not been considered as a whole and further that the *prima facie* case of obviousness has not been established.

Claim 1, requires, “receiving a message for a recipient from a sender device at a message server without the sender device placing a call to the recipient”. The Office Action notes that *Kung* fails to teach this requirement and states that “leaving a message to a called recipient as a result of an unsuccessful call to the called party placed by a calling party . . . differs from [the] claimed invention where the calling party does not need to place the call to the called party that results in leaving the message.” See Office Action page 4.

The Examiner attempts to remedy this deficiency by suggesting that this requirement is taught by *Bergsman*. The Examiner alleges that *Bergsman* teaches “a system and method in which a calling party placing a call to a voice mail system, leaving a message for a called recipient and requesting the voice mail system to deliver his message to the called recipient.” See *Id.*

Applicant disagrees with this characterization for several reasons. First, the Examiner notes in the Office Action that *Bergsman* teaches a system and method in which a calling party is placing a call to a voice mail system . . . .” More particularly, Figure 1 of *Bergsman* begins

when the caller initiates a call to the system, as noted by the Examiner. *See* Figure 1. The caller can then interact with the system to record a message and to specify the date and time of the delivery. At the appointed time, however, the system then calls the recipient to deliver the previously recorded message. *See* Figure 2. As a result, the recipient would never be able to receive the message but for the system calling the recipient. Both *Bergsman* and *Kung* therefore teach that the delivery of a message only occurs after the initiation of a call to the recipient: in *Kung*, the call is initiated by a caller and in *Bergsman*, the call is ultimately made by a system.

Another clear error, among others, relates to the requirement in claim 1, which requires “a request for the stored voice content” from the recipient device. The request is made in response to an SMS notification that includes information permitting the recipient wireless station to access the IVR system. The Examiner suggests that these requirements are taught by *Kung*. Applicants respectfully disagree.

For example, the notification required by claim 1 includes information that permits the recipient to make the request for the stored content. As noted in the specification, one example of such information is a telephone number that the recipient may call. *See e.g.*, Specification ¶[09]. Without the information included in the notification, the recipient would be unable to access the voice content. Thus, the message generated by the sender device is received at a message server that is associated with the sender device, not with the recipient device. Because of this association, the recipient is typically unable to access the voice message without the information included in the SMS notification. As a result, the SMS notification in claim 1 permits the recipient wireless station to access the IVR system and request the stored content.

This requirement of claim 1 is not suggested by a message box that is associated with the recipient, which is what *Kung* teaches. For example, the notification taught by *Kung* may be “an active message waiting indicator light, and/or an active intercom with speaker. *See* col. 40, lines 57-58. An active message waiting indicator may inform the recipient that a message has been received, but no information (such as information that permits the recipient to access the voice content as required by claim 1), is communicated to the recipient in *Kung* because the message is already in the recipient’s message box, which is always accessible to the recipient. For example, reference number 702 in Figure 7A of *Kung* illustrates that a call is forwarded to a message box

when a call is received. In contrast, the message of claim 1 is at a message server that the recipient cannot access unless he or she received the notification required by claim 1.

Although the Examiner cites to Figures 7A – 8C of *Kung* as teaching various aspects of claim 1, these teachings all depend on the fact that the caller places a call to the recipient. The caller is unable to leave or send any message in *Kung* without placing an initial call to the recipient. Because a call is placed to the recipient, any message left by the caller is stored in the recipient's message box. Failing to consider the fact that a call is made by the caller to the recipient (as taught by both *Kung* and *Bergsman*) indicates that the Examiner is using impermissible hindsight to reconstruct the claim, especially when the claims require without placing a call to the recipient.

*Kung* alternatively teaches that “a party may send a broadband network subscriber a message without calling the subscriber, by sending an email, voice mail, or video mail message that was pre-recorded to the party by sending it to, for example, the subscribers email address, IP address, or DN.” *See* col. 40, ¶[0112]. However this aspect of *Kung* fails to teach or suggest claim 1 for multiple reasons. In particular, *Kung* teaches that the message is sent to the recipient's email address, IP address, or DN. *See Id.* As discussed above, the message in claim 1 is required to be sent to a message server that is associated with the sender and not to the recipient's email address, IP address, or DN, which is taught by *Kung*. When considering the claim as a whole, the teaching of sending a message to an email or IP address is unrelated to the requirement of sending a notification to a recipient with information that permit the recipient to make a request for the voice content as required by claim 1.

In view of these clear distinctions, it appears that the Examiner is using the patentee's claim as a blueprint to reconstruct the pending claims. It is error to use hindsight in this manner. “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added).

As stated above, both *Kung* and *Bergsman* require that a call is placed to the recipient. Claim 1, in contrast, requires a notification be sent and then requires that a request be received

from the recipient before delivering the stored message. In effect, the notification causes the recipient to initiate a call to access the stored voice content. Thus, the teaching of placing a call does not provide the necessary motivation that results in a notification that includes information permitting the recipient to access the voice content.

Thus, the Examiner has failed to consider the claim as a whole as required when making rejections under 35 U.S.C. § 103 and has impermissibly used hindsight vision afforded by the claims. Further, the cited art fails to teach all of the limitations of the pending claims, examples of which are discussed above. For at least the reasons, the Examiner has failed to establish a *prima facie* case of obviousness and claim 1 is not rendered obvious by the cited art and allowance is respectfully requested. The other independent claims 14, 21, 23, and 26 have similar requirements and therefore overcome the art for at least the same reasons. The pending dependent claims are also in condition for allowance for at least the same reasons.

Thus, the Applicants respectfully request the Panel to consider whether the Patent Office's burden has been met to supply a *prima facie* case of obviousness with respect to claims 1-26 and 28-35 prior to Applicants' submission of the Appeal Brief.

#### **Conclusion**

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 12<sup>th</sup> day of May 2006.

Respectfully submitted,



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